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09/641,030	08/17/2000	Leanne M. Capozzi	81503F-P	4827

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PATENT LEGAL STAFF
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EXAMINER

HENDERSON, MARK T

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/641,030

Applicant(s)

CAPOZZI ET AL.

Examiner

Mark T Henderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23, 51 and 52 is/are pending in the application.
4a) Of the above claim(s) 51 and 52 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-14, 16-23 is/are rejected.
7) ☒ Claim(s) 15 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

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DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9302 (Official) and (703)872-9303 (for After Finals). This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claims 24-50 have been canceled.

Election/Restriction

2. Submitted claims 51 and 52 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claim 1 discloses the limitation of

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a kit having an instruction form having a code which does not require the limitations of the code being machine read, since these limitations do not structurally limit the claim. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by a different process (see MPEP 2113). Therefore, it would be obvious to incorporate an instructional form having a code capable of being human read.

Although the method claims (51 and 52) now disclose a new method (a method of organizing a plurality of image), it does not mean that these claims can be grouped with the apparatus claims (1-23, since they are restrictable as stated above. Furthermore, the general policy of the office is not to permit the applicant to shift to claiming another invention after an election is once made and an action is given on the elected subject matter. Note that the applicant cannot, as a matter of right, file a request for continued examination (RCE) to obtain continued examination on the basis of claims that are independent and distinct from the claims previously claimed and examined (i.e., applicant cannot switch inventions by way of an RCE as a matter of right). When claims are presented which the examiner holds are drawn to an invention other than the one elected, he or she should treat the claims as outlined in *MPEP* § 821.03.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 51 and 52 have been withdrawn from consideration as being directed

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to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. The requirement is still deemed proper and is therefore made FINAL.

Furthermore, applicant has disclosed that claims 49 and 50 are withdrawn, when in fact they have been canceled as stated in applicant's response on January 21, 2003.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-7 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson et al (3,895,220).

Nelson discloses a kit comprising: an order form (12) for ordering goods provided on a plurality of hard copy prints (16a-16d); an instruction form (14) on how to use the kit and having a machine readable code (18) to provide and obtain information; wherein the instructions are on a hard copy document with a visual format; and an envelope holder with a pocket (34).

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However, Nelson et al does not disclose a kit for organizing a plurality of images; an instruction form for association with the plurality of hard copy prints; information used in organizing digital images into groups or categories; information for use in organizing the images; a holder for organizing the images ; pockets for organizing the images and for associating the instruction form with the plurality of hard prints.

In regards to **Claims 1, 5, and 6**, a recitation of the intended use (for organizing images) of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. Therefore, the instruction form, code and holder pockets of Nelson et al are capable of being associated with a plurality of hard copy prints; capable of being machine read; used for providing information used in organizing digital images into groups or categories; and for associating the instruction form with the plurality of hard copy prints.

In regards to **Claims 1 and 5**, the digital images obtained by scanning does not structurally limit the claim. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by a different process (see MPEP 2113). Therefore, it would be obvious to obtain the images by scanning of a print.

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In regards to **Claim 6**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include as many pockets in the envelope as desired, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. Therefore, it would be obvious to include as many pockets, since an envelope having additional pockets would work equally as well and wherein the pockets could be used for holding additional information.

4. Claims 1-14, 16 and 21-23 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Wentworth (5,547,226) in view of Hicks (5,359,387) and further in view of Johnson et al (5,060,980).

Wentworth discloses in Fig. 1, a kit for organizing comprising various forms (Col. 3, lines 40-46) which can be placed in the kit; a hard copy instruction form document in visual format (as seen in Fig. 2); an envelope holder (12) which can include pockets (Col. 3, lines 51-53); and a container (11) having other sections for holding other formats such as cards.

However, Wentworth does not disclose: a kit for organizing images; an instruction form having a code capable of being machine read so as to obtain information for use in organizing; instructions on how to use the kit; a holder and pocket for organizing images; an instruction associated with a unique order instruction, and information associated with the images; a container for holding images; wherein the code comprises a color for the instruction form;

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wherein the instruction form is the same size as the hard copy prints; and a tool for use in determining the number of the image to be scanned.

Hicks discloses in Fig. 2, an order form (14) for ordering goods (26), wherein the order can be read by a tool (computer data base and reading device, as stated in Col. 4, lines 5-26).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Wentworth's kit to include an order form as taught by Hicks for the purpose of ordering items desired by the end user.

However, Wentworth as modified by Hicks does not disclose an instruction form having a code so as to obtain information; instructions on how to use the kit; an instruction associated with a unique instruction, and information associated with the images; a holder and pockets for organizing images; a container for holding images; wherein the code comprises a color for the instruction form; and wherein the instruction form is the same size as the hard copy prints.

Johnson et al discloses in Fig. 1, a form which can comprise instructions (Col. 6, lines 5-8 and 15-18), machine readable code (26) which can be in any form such as an icon (Col. 4, lines 62-64), and human readable indicia (12).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Wentworth's kit to include an instruction form having encoded indicia as taught by Johnson et al for the purpose of informing the end user.

In regards to **Claims 1, 2, 5, 6, 8, 9, 12-14 and 21**, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the

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prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. Therefore, the kit of Wentworth is capable for organizing a plurality of images.

In regards to **Claim 9 and 10**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have any desired instructional information, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus there is no novel and unobvious functional relationship between the printed matter and the substrate that is required for patentability. Therefore, the instructional information of the Wentworth et al is capable of disclosing instruction on how to use a kit and instruction associated with a unique instruction.

In regards to **Claim 22**, matters related to the choice of ornamentation producing no mechanical effect or advantage considered to constitute the invention are considered obvious and do not impart patentability. Therefore, it would be obvious to make the code of Wentworth as modified by Hicks and Johnson et al in any color , since applicant has not disclosed the criticality of having a colored code, and further wherein the code would operate equally as well in any color.

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In regards to **Claim 23**, it would have been an obvious matter of design choice to construct the instruction form in any desirable size, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. Therefore, it would be obvious to make the code of Wentworth in any size, since applicant has not disclosed the criticality of having an instructional form of a particular size, and further wherein the instructional form would function equally as well in any desired since it is only disclosing information.

5. Claim 17-20 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Wentworth (5,547,226) in view of Hicks and Johnson et al, and further in view of Kawai et al (6,043,866).

Wentworth as modified by Johnson et al and Hicks discloses a kit comprising all the elements as claimed in claim 1, and as set forth above.

However, Wentworth does not disclose carrier for holding an imaged sheet for allowing automatic feeding of the image through a scanning device, wherein the carrier comprises an adhesive layer, alignment marks, and a retaining member for securely holding the hard copy prints that are to be scanned.

Kawai et al discloses in Fig. 5, a carrier for holding an imaged sheet (G) for allowing automatic feeding of the image through a scanning device, wherein the carrier comprises and adhesive layer (4), alignment marks (2a) for assisting in positioning, and a retaining member (3).

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Wentworth's kit to include a carrier form as taught by Kawai et al for the purpose of protecting an original imaged sheet from being ruined by a scanning device.

In regards to **Claim 20**, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. Therefore, the retaining member of Wentworth as modified by Kawai et al is capable for securely holding scanned prints.

Allowable Subject Matter

6. Claim 15 is finally objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Response to Arguments

7. Applicant's arguments filed on July 18, 2003 have been fully considered but they are not persuasive.

In regards to Applicant's arguments that the Nelson reference does not teach: a code for providing the function (providing information that is used in organizing digital images) as taught by the applicant, the examiner submits that Nelson does indeed teach the structural limitation of a form having a code. However, in regards to the code that provides information used in organizing digital images, the examiner submits that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Therefore, the code of Nelson is capable of providing information in organizing images.

In regards to applicant's argument that the Nelson reference does not suggest or teach a plurality of hardcopy prints having images, the examiner submits that applicant never discloses "a plurality of hardcopy prints having images". The claims clearly disclose a "kit for organizing a plurality of images provided on a plurality of hard copy prints"; and an "instruction form for association with said plurality of hard copy prints". The limitations for the kit and instruction form are clearly deemed as intended use. Furthermore, a recitation of the intended use of the

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claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Therefore, the kit and instruction form of Nelson et al are capable of being associated with a plurality of hard copy prints; capable of being machine read; used for providing information used in organizing digital images into groups or categories; and for associating the instruction form with the plurality of hard copy prints.

In regards to applicant's argument that the Wentworth, Hicks and Johnson et are "of little relevance to the present invention, the examiner submits that applicant's arguments amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Wentworth, Hicks and Johnson clearly disclose the structural limitations of the claims. Again however, applicant further discloses the structural limitations of the claims with associated intended use language. Again as stated above and in the rejections, the examiner submits that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Therefore, the kit and instruction form of Wentworth as modified by Hicks and Johnson et al are capable of being associated with a plurality of hard copy prints; capable of being machine

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read; used for providing information used in organizing digital images into groups or categories; and for associating the instruction form with the plurality of hard copy prints.

Therefore, the rejections have been maintained.

Conclusion

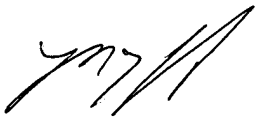
8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

August 9, 2004



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